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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,206	10/10/2000	Jack D. Robinson	7933P001	6139
8791 7590 10/15/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER CHRISTENSEN, SCOTT B				
ART UNIT 2444		PAPER NUMBER		
MAIL DATE 10/15/2008		DELIVERY MODE PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/686,206
Filing Date: October 10, 2000
Appellant(s): ROBINSON ET AL.

Kevin G. Shao
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/17/2008 appealing from the Office action mailed 2/19/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6088032	MACKINLAY	7-2000
20010019332	FISHER	9-2001
6677964	NASON	1-2004

"CNET: Downloads". downloaded from

<<http://web.archive.org/web/19991008154521/http://download.com/>>. Posted on the Internet October 8, 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3-10 and 12-19 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claim 3, the instant claim recites, "wherein the 3D computing environment can be deactivated," where the specification does not appear to describe deactivating the 3D computing environment.

Further, with regard to claim 3, the instant claim recites, "without displaying the 2D desktop environment first." The specification describes on page 11, lines 7-9, describes how the monitor immediately displays the computer desktop as a 3D computing environment, but does not specifically disclose that the 2D environment is not displayed.

With regard to claims 4-10, the instant claims depend from claim 3, and are rejected for the same.

With regard to claims 12-19, the instant claims are substantially similar to claims 12-19, and are rejected for substantially similar reasons.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 7,168,051.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-4 of the instant application and claims 1 and 9 of Patent 7,168,051 (other than the use of the terms "first computer

system" and "first user" without the inclusion of a second computer system or a second user in Patent 7,168,051 as opposed to "a computer system" and "a user" in the instant application.) is **First**, "including displaying at least a portion of the content of the converted web page in a persistent client window of the 3D desktop that is persistent even if a connection between the first computer system and the Internet has been terminated" (as presented in Patent 7,168,051), **Second**, "downloading a 3D (three dimensional) environment development program to a computer system from a Web server over the Internet and executing the 3D development program within the computer system to convert a 2D (two dimensional) desktop environment of the computer system into a 3D computing environment, including installing an interpreter within an operating system of the computer system" (as in the instant application), **Third**, the use of the term "application program" instead of "Web page" (as in the instant application, and **Fourth**, the instant application includes limitations that merely require a server to provide updates and additional content, then to have the user's computer store the updates and content ("accessing a registry server over the Internet to download additional 3D graphical objects to be used in the 3D desktop, wherein the registry server is associated with an community having a plurality of members, and wherein the registry server is configured to maintain 3D graphical objects, including the downloaded 3D graphical object, used by the plurality of members including software updates to the 3D desktop; and storing the downloaded 3D graphical objects in a repository within the computer system, wherein the repository is configured to store all graphical objects used by the 3D desktop, including graphical objects downloaded over the Internet,

updates from the registry server, and user defined objects defined locally by a user of the computer system.”).

First, the ability to navigate to a Web page, and continue to view the single Web page in a browser window is very well known in the art, and has been implemented before the filing of the instant application in versions of Internet Explorer, Netscape Navigator, and other browsers. When a user connects to a Web page using one of these browsers, the page stays on the screen, even if the user disconnects from the Internet, until the user closes the window. When this functionality is implemented in the invention as claimed in claims 1-2, the 3D environment would download the information for the Web page, and display the Web page until it is navigated away from or closed, even when the connection to the Internet is terminated.

Second, the limitation in claims 1 and 2 of the present application of “downloading a 3D (three dimensional) environment development program to a computer system from a Web server over the Internet and executing the 3D development program within the computer system to convert a 2D (two dimensional) desktop environment of the computer system into a 3D computing environment, including installing an interpreter within an operating system of the computer system” amounts to nothing more than downloading the software to perform the remaining steps of the method from a Web server and installing and executing the program to execute the steps. Downloading software from a Web server is very well known in the art to provide a fast and low cost means for distribution of software with options to grant limitations of use on the software until the user pays some sort of licensing fee (i.e.

shareware). Further, when software is downloaded, the only way for a user to benefit from the software is to install it on his or her own computer.

Third, as in the instant specification on page 16, lines 10-13, an application may exist on a webpage or off, meaning that an application is reasonably interpreted as being any feature on a web page that is interactive or dynamic in nature (as opposed to static text) or any other program or software. Thus, the difference between a Web page and Application program is not a patently distinct one, as it is extremely well known in the art to provide interactive or dynamic features on a Web page, which according to the instant disclosure, may be interpreted as being an application.

Fourth, servers to provide updates and additional content for software applications of all kinds are well known in the art, as is downloading and storing the content on a computer system (This limitation's obviousness is further detailed below in the rejection of claim 1).

Accordingly, the claims 1 and 9 of Patent 7,168,051 are obvious in view of the claims 1-2 of the instant application. Furthermore, claims 1-2 of the instant application are obvious in view of claims 1 and 9 of Patent 7,168,051. As such, neither claims 1-2 of the instant application nor claims 1 and 9 of Patent 7,168,051 are patently distinct, thus claims 1-2 of the instant application are rejected on the ground of nonstatutory obviousness-type double patenting.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 6,088,032 to Mackinlay, hereafter referred to as "Mackinlay."

With regard to claim 1, Mackinlay discloses a computer-implemented method comprising:

providing the 3D computing environment representing a 3D desktop of a computer system in a 3D environment which is presented as a 3D desktop in a 3D room environment, wherein one or more icons of the 2D desktop environment are spacially displayed on multiple surfaces of the 3D room environment (Mackinlay: Figures 2-9 and 13-16 and column 4, lines 43-49 and Figure 2a. It is noted that the documents that are represented in the icons in Mackinlay are icons that are also represented in the 2D desktop environment.);

receiving a two-dimensional application program (Mackinlay: Column 11, line 62 to column 12, line 8. As the environment is being used to perform operations with respect to a web page, the web page must have been received. It is noted that application programs may also be components within the web page, and are thus part of many web pages. Further, according to Mackinlay: Column 7, lines 5-22, pages are

interacted with using a browser capable of viewing HTML formatted documents, the browser, itself, also being an application.);

the interpreter dynamically converting the two-dimensional application program to a form usable in the three-dimensional computing environment (Mackinlay: Column 5, lines 41-50); and

presenting the content of the converted application program within the 3D computing environment (Mackinlay: Figures 13 and 14) to allow a user of the computer system to navigate the content of the application program within the 3D computing environment (Mackinlay: Column 11, line 63 to column 13, line 9. The ConeWalker allows users to navigate the web pages.).

Mackinlay does not disclose expressly:

downloading a 3D (three dimensional) environment development program to a computer system from a Web server over the Internet;

executing the 3D development program within the computer system to convert a 2D (two dimensional) desktop environment of the computer system into a 3D computing environment, including installing an interpreter within an operating system of the computer system;

accessing a registry server over the Internet to download additional 3D graphical objects to be used in the 3D desktop, wherein the registry server is associated with an community having a plurality of members, and wherein the registry server is configured to maintain 3D graphical objects, including the downloaded 3D graphical object, used by the plurality of members including software updates to the 3D desktop; and

storing the downloaded 3D graphical objects in a repository within the computer system, wherein the repository is configured to store all graphical objects used by the 3D desktop, including graphical objects downloaded over the Internet, updates from the registry server, and user defined objects defined locally by a user of the computer system.

A person of ordinary skill in the art would have known how to perform the steps of downloading a 3D (three dimensional) environment development program to a computer system from a Web server over the Internet and executing the 3D development program within the computer system to convert a 2D (two dimensional) desktop environment of the computer system into a 3D computing environment, including installing an interpreter within an operating system of the computer system.

It is noted that the claim limitations are met by having the software program performing the functionality in the claim (providing the 3D computing environment, receiving a two-dimensional application program, converting the two-dimensional application program, and presenting the content of the converted application program) on a web server, then having the client download the software program (downloading a 3D (three dimensional) environment development program to a computer system from a Web server over the Internet) then installing and running the program to show the 3D desktop environment, where the interpreter is simply a software module within the program (executing the 3D development program within the computer system to convert a 2D (two dimensional) desktop environment of the computer system into a 3D computing environment, including installing an interpreter within an operating system of

the computer system.). Downloading software from the Internet, and thus from a Web server, was notoriously well known in the art (see, for example, "CNET: Downloads," downloaded from <http://web.archive.org/web/19991008154521/http://download.com/>, posted October 8, 1999, hereafter referred to as "CNET." CNET allows software programs of all types to be downloaded to a user's computer, where the user can then install and run the software program.

It would have been obvious to perform the steps of downloading a 3D (three dimensional) environment development program to a computer system from a Web server over the Internet and executing the 3D development program within the computer system to convert a 2D (two dimensional) desktop environment of the computer system into a 3D computing environment, including installing an interpreter within an operating system of the computer system.

The suggestion/motivation for doing so would have been that providing programs to be downloaded from a Web server to be installed and executed by a user allows the software to be distributed very rapidly to users in a large area. The software can even be a limited version (i.e. shareware) that demonstrates the capabilities of the software, allowing a user to evaluate the software before purchasing a full version of the software from the company, the purchasing of which could either be performed through another download, or a registration key in order to unlock features that were presented in the downloaded version. This gives the user a chance to try a software package that he/she may not have otherwise tried, then purchase the software package.

Further, a person of ordinary skill in the art would have known how to have a server on the Internet for providing additional content and software updates to users of the software (accessing a registry server over the Internet to download additional 3D graphical objects to be used in the 3D desktop (the server with additional content (graphical objects) and updates), wherein the registry server is associated with an community having a plurality of members (the server is associated with the users of the system, which is a community having a plurality of members), and wherein the registry server is configured to maintain 3D graphical objects, including the downloaded 3D graphical object, used by the plurality of members including software updates to the 3D desktop (the server is capable of storing the required information).). Further, with such a server, it would have been well known how to store the downloaded 3D graphical objects in a repository (memory) within the computer system, wherein the repository is configured to store all graphical objects used by the 3D desktop, including graphical objects downloaded over the Internet, updates from the registry server, and user defined objects defined locally by a user of the computer system (any hard drive or memory is configured to store any information that can be contained within the amount of space on the memory or hard drive.). For example, US Patent 6,677,964 to Nason et al. discloses that definition files (content) and updates may be downloaded for the software disclosed by Nason (Column 39, lines 26-49).

It would have been obvious to a person of ordinary skill in the art to access a registry server to download 3D graphical objects (content) to be used in the software of

Mackinlay and have the server additionally storing updates. It would have also been obvious to store the graphical objects in the computer system of the user.

The suggestion/motivation for doing so would have been that providing additional content and updates from a server to the users of the software of Mackinlay would provide customers with support that would attract more customers to the provider of the software. Further, a person of ordinary skill in the art would have been motivated to provide convenient ways for the customer to download the content and updates, which would be from a server over the Internet.

With regard to claim 3, Mackinlay teaches the invention as substantially claimed except:

wherein the 2D desktop environment is an existing desktop environment as a part of the operating system of the computer system, and wherein the 3D computing environment is installed from the 2D desktop environment;

wherein the 3D computing environment can be activated from the 2D desktop environment in response to a user request in which the 2D application program is converted by the interpreter into a 3D application and the graphical objects are presented in a 3D manner;

wherein the 3D computing environment can be deactivated to reinstate the 2D desktop environment in response to a user request in which the 2D application program is not converted into a 3D application and the graphical objects are presented in a 2D manner; and

wherein when the 3D computing environment is activated, the 3D computing environment is automatically presented when the computer system reboots without having to display the 2D desktop environment first.

It would have been obvious to have the 2D desktop environment is an existing desktop environment as a part of the operating system of the computer system, and wherein the 3D computing environment is installed on the top of the 2D desktop environment.

The suggestion/motivation for doing so would have been that most operating systems available at the time of filing of the instant application had a GUI which utilized some sort of 2D desktop (i.e. Windows, several versions of Linux, and Mac OS). Any program installed in one of these operating systems would be installed from the 2D desktop environment. Therefore, the program disclosed by Mackinlay would benefit from allowing the claimed functionality, as it is required in order to install in most of the popular operating systems without severely changing the way the operating system functions (i.e. rewriting a significant portion of the code of the operating system itself).

It would have been obvious to allow Mackinly to allow the 3D computing environment to be activated from the 2D desktop environment, and allow the 3D computing environment to be deactivated to reinstate the 2D desktop environment in response to a user request.

The suggestion/motivation for doing so would have been that allowing the program to utilize Microsoft Windows allows the software to be utilized on the most popular operating system platform. Microsoft Windows allows for programs to be

activated, whether the user manually activates the program, or the operating system is set up to automatically start the program. Programs can also typically be deactivated by using code that is typically included in most software programs to allow the program to be deactivated (making the software more user-friendly), using the task manager to force the program to close, and/or using the add/remove programs feature of Microsoft Windows to remove the software from the operating system all together. When any of these functions are performed, the software would be deactivated, reinstating the regular desktop of Microsoft Windows. In this case, activating the software enables the 3D desktop and deactivating the software disables the 3D desktop, returning the user to the 2D desktop.

It would have been obvious to have it so that when the 3D computing environment is activated, the 3D computing environment is automatically presented when the computer system reboots without displaying the 2D desktop environment.

The suggestion/motivation for doing so would have been that some of the most popular operating systems allows for software to be automatically started when the computer is booted. For example, Microsoft Windows allows for programs to automatically be started as services, or to be started from the "Startup" folder in the Start menu. The program can either be started up within a window that does not take up the entire screen or in a window that takes the entire screen (or full screen mode). In the latter case, the user has a larger environment to work with, and does not involve displaying the 2D desktop environment (as the entire environment would either be

behind the full screen display of the 3D environment or would be not currently activated if the program of Mackinlay is operated as a full screen application.

With regard to claim 4, Mackinlay teaches the invention as substantially claimed except:

developing 3D enabled applications using a software development kit (SDK) within the computer system, the 3D enabled applications developed by the SDK can be presented in a 3D manner in the 3D desktop; and

accessing the registry server over the Internet to download software updates associated with the SDK.

However, it was well known in the art to have an SDK for developing 3D software applications that are capable of being presented in a 3D manner in the 3D desktop and to download software updates associated with the SDK.

It would have been obvious to have an SDK for developing 3D software applications that are capable of being presented in a 3D manner in the 3D desktop.

The suggestion/motivation for doing so would have been that SDKs that can be used for developing 3D applications are well known in the art (i.e. DirectX and OpenGL). These SDKs were available, at the time of the invention, for download and installation, and were used to develop 3D applications. Further, users often create plug-ins or mods for different applications, where the plug-ins or mods would be created by the user using some form of a software development kit. Creating the plug-ins or mods allows the user to modify the functionality of software (in this case, the software of

Mackinlay) to suit the individual user's tastes. It is further noted that the Open Source community encourages users to modify programs by creating plug-ins or directly modifying the code of the application. It is noted that the software updates only need to be somehow associated with the SDK, where how the updates are associated with the SDK is not defined. Being on the same computer system constitutes being "associated."

With regard to claim 5, Mackinlay teaches the invention as substantially claimed except that the Web server comprises a maintenance system and database communitively coupled to the registry server for periodic updates of 3D computing environment-based protocols, as well as graphical objects stored in the Web server as a library, wherein by storing the graphical objects in the maintenance system and database of the Web server, the SDK can be used by users to automatically generate 3D enabled Web pages without having the SDK on their desktops.

However, it would have been well known in the art to have the Web server comprises a maintenance system and database communitively coupled to the registry server for periodic updates of 3D computing environment-based protocols, as well as graphical objects stored in the Web server as a library. The remaining claim language, "wherein by storing the graphical objects in the maintenance system and database of the Web server, the SDK can be used by users to automatically generate 3D enabled Web pages without having the SDK on their desktops" is clearly intended use, and does not have any limiting affect on the method as claimed, as this is clearly a hypothetical

possibility that relies on the graphical objects being stored in the maintenance system allowing some functionality to occur, where the functionality doesn't necessarily occur.

It would have been obvious to have a maintenance system and database communitively coupled to the registry server for periodic updates of 3D computing environment-based protocols, as well as graphical objects stored in the Web server as a library.

The suggestion/motivation for doing so would have been that the modified software of Mackinlay allows for software updates, so having some maintenance system and database connected to the registry server within the single web server would allow the updates to be provided for while maintaining records of the updates and some maintenance of the files, system, or connections to occur. It is noted that neither the database or maintenance system have any functionality claimed, only that they are somehow coupled to the registry server for the purposes of providing periodic updates.

With regard to claim 6, Mackinlay teaches the invention as substantially claimed except:

purchasing the 3D environment development program from an e-commerce server over the Internet;

in response to the purchase, the e-commerce server notifying the Web server to allow the computer system to download the purchased 3D environment development program from the Web server; and

the e-commerce server subsequently delivering advertisement information to the computer system to be represented within the 3D desktop of the computer system.

However a person of ordinary skill in the art would have known how to allow a user to purchase the software of Mackinlay over the Internet from an e-commerce server, have the e-commerce server notify the Web server to allow the download, and subsequently delivering advertisement information to the computer system to be represented in the 3D desktop environment of the computer system.

It would have been obvious to allow a user to purchase the software of Mackinlay over the Internet from an e-commerce server, have the e-commerce server notify the Web server to allow the download, and subsequently delivering advertisement information to the computer system to be represented in the 3D desktop environment of the computer system.

The suggestion/motivation for doing so would have been that allowing users to purchase software over the Internet and subsequently downloading the software allows the publisher of the software to quickly sell the software to a larger user base in a convenient fashion that reduces the cost associated with the transaction (e.g. packaging the software and providing a disk or other means for carrying the program code). Having an e-commerce server handling the purchases allows the purchases to be performed by a secure server either owned by the publisher, or offload the e-commerce functionality to a third party for processing payment information. Having the e-commerce server notify the Web server that the download is purchased, and can be downloaded allows the publisher to avoid providing free software to users. Lastly,

delivering advertisement information allows the software publisher and/or e-commerce server to generate additional funds through the advertising. Having the advertising presented within the 3D desktop environment ensures that the user is exposed to the advertising when the software is used.

With regard to claim 7, Mackinlay does not disclose expressly:

wherein executing the 3D development program within the computer system comprises installing a persistent kernel within the computer system, wherein a user of the computer system is provided with a demonstration of the purchased 3D desktop for the user to decide whether to activate the 3D desktop, wherein if the user chooses not to activate the 3D desktop, the persistent kernel is still active in an unobtrusive 2D persistent window on the user's desktop for delivering and presenting advertisement information to the user, wherein the registry server maintains information regarding downloads information to a plurality of computer systems and purchased from the e-commerce server, including user profiles, buying patterns, and searches.

However, it was well known in the art to provide demonstration versions of software (shareware), where the demonstration version has a cost associated with it, then allowing the user to activate the software (usually by paying a fee for the full version). Further, it was well known to bundle advertising software with software packages, where the advertising software presents advertisements in a fashion that does not hinder the user's experience (unobtrusive), but cannot be closed easily (persistent), and cannot be uninstalled easily (persistent kernel). Further, it was well

known in the art to maintain information of users that access systems and/or services to third parties.

Thus, it would have been obvious to provide demonstration versions of software (shareware), where the demonstration version has a cost associated with it, then allowing the user to activate the software (usually by paying a fee for the full version) (wherein a user of the computer system is provided with a demonstration of the purchased 3D desktop for the user to decide whether to activate the 3D desktop). Further, it was well known to bundle advertising software with software packages, where the advertising software presents advertisements in a fashion that does not hinder the user's experience (unobtrusive), but cannot be closed easily (installing a persistent kernel within the computer system) (the persistent kernel is still active in an unobtrusive 2D persistent window on the user's desktop for delivering and presenting advertisement information to the user), and cannot be uninstalled easily (persistent kernel). Further, it was well known in the art to maintain information of users that access systems and/or services to third parties (wherein the registry server maintains information regarding downloads information to a plurality of computer systems and purchased from the e-commerce server, including user profiles, buying patterns, and searches).

The suggestion/motivation for doing so would have been that offering a shareware package allows the user to evaluate the software before purchasing the full-priced software, allowing users that would not otherwise purchase the software to try the software and perhaps change their minds. Further, charging for the shareware

allows the company to ensure that some of the costs of distributing the shareware package (e.g. storage) is recovered. Bundling some sort of adware (advertising software) with the software package allows the publisher to generate revenue from advertisers. Further, having a persistent window with a persistent kernel ensures that users cannot readily get rid of the advertising, allowing for more exposure of the advertisements, making the service more valuable for the advertiser. Maintaining information on profiles, buying patterns, searches, downloads, and purchases allows the publisher to generate profiles that can be used for advertising purposes, whether by selling the information to advertisers, or creating demographic information to demonstrate to advertisers that the population that is utilizing the software would be an effective population to advertise to.

With regard to claim 8, Mackinlay does not disclose expressly that the registry server is accessible from the e-commerce server to obtain information about users of the e-commerce server, such that the e-commerce server can generate targeted advertising and product offerings for a particular user.

However, it would have been well known to allow e-commerce servers to access information on the registry server to allow targeted advertising to be generated.

It would have been obvious to allow e-commerce servers to access information on the registry server to allow targeted advertising to be generated.

The suggestion/motivation for doing so would have been that revenue can be generated by selling information to the e-commerce server about the users that access the registry server.

With regard to claims 2 and 12-17, the invention claimed is substantially similar to the invention claimed in claims 1 and 3-8, respectively, and are rejected for substantially similar reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackinlay in view of Fisher in US Patent Application 2001/0019332, hereafter referred to as "Fisher."

With regard to claim 9, Mackinlay teaches the invention as substantially claimed except:

accessing a community server over the Internet via the 3D desktop, the community server providing information and services to a community having a plurality of members;

activating a 3D version of the community server via a user interface of the community server; and

in response to the activation, the community server communicating with a 3D environment special shell component having a 3D representation of a 2D environment previously available from the community server, such that instead of viewing the content provided by the community server in a 2D manner, a user of the computer system can access the same content in a 3D manner using the 3D desktop of the computer system.

However, Fisher teaches:

accessing a community server over the Internet, the community server providing information and services to a community having a plurality of members (Fisher: Paragraph [0014]);

activating a 3D version of the community server via a user interface of the community server (Fisher: Paragraph [0014]); and

in response to the activation, the community server communicating with a 3D environment special shell component having a 3D representation of a 2D environment previously available from the community server, such that instead of viewing the content provided by the community server in a 2D manner, a user of the computer system can access the same content in a 3D manner using the 3D desktop of the computer system (Fisher: Figure 3).

It would have been obvious to access the system of Fisher within the teachings of Mackinlay.

The suggestion/motivation for doing so would have been that Mackinlay is concerned with accessing Web Pages downloaded from the Internet (Mackinlay: Column 2, lines 10-14). Allowing Mackinlay to access the system disclosed by Fisher allows users access 3-dimensional information about products that would otherwise only be available as 2-dimensional pictures, allowing a user to better evaluate the product to be purchased (Fisher: Paragraphs [0010] to [0011]).

With regard to claim 10, Mackinlay as modified by Fisher teaches:
navigating content of the community server in a 3D manner via the 3D desktop of the computer system (Fisher: Figure 3).

Mackinlay as modified by Fisher do not teach expressly:
interacting with other members of the community in a 3D manner via the 3D desktop of the computer system.

However, a person of ordinary skill in the art would have known how to allow the user to interact with other members of the community in a 3D manner via the 3D desktop of the computer system.

It would have been obvious to allow the user to interact with other members of the community in a 3D manner via the 3D desktop of the computer system.

The suggestion/motivation for doing so would have been that providing an evaluation system for the items presented in the disclosure of Fisher would allow users to interact with each other by reviewing the products being viewed by the user. This

information would be accessed in a 3D manner, as the page is presented within the 3D environment.

With regard to claim 11, the subject matter disclosed in claim 11 is substantially similar to that in claim 7, and is rejected for substantially similar reasons.

With regard to claims 18-20, the instant claims are substantially similar to claims 8-11, and are rejected for substantially similar reasons.

(10) Response to Argument

Issue 1: On pages 10-11 of the Appeal Brief, Appellant argues the rejection of claims 3-10 and 12-19 under 35 USC 112, First Paragraph. More specifically, Appellant argues that "wherein the 3D computing environment can be activated from the 2D desktop environment," "wherein the 3D computing environment can be deactivated," and "the 3D computing environment is automatically presented when the computer system reboots without having to display the 2D desktop environment first."

It is noted that Appellant never shows where support for the claim limitations in question are found within the specification. Rather, Appellant argues that these limitations are somehow needed for the purpose of the present invention as claimed. It is noted that the claims as originally filed on 10/10/2000 did not include these limitations. Further, these limitations are not even in the independent claims as currently presented. Therefore, it is clear that Appellant intends for the independent

claims to have a broader scope than having the 3D computing environment being able to be activated and deactivated, and having the 3D computing system presented without having to display the 2D desktop environment first. Further, the complete silence in the specification, as well as in the independent claims, with regard to these limitations makes it clear that these limitations are not required for the purposes of the disclosed invention.

Further, Appellant points out that the Office Action mailed 2/19/2008 acknowledges that the specification describes how the monitor immediately displays the 3-D desktop on page 10 of the Appeal Brief. However, this statement, while appearing to support "the 3D computing environment is automatically presented when the computer system reboots," as in claim 3, clearly does not support "without having to display the 2D desktop environment first."

Thus, the rejection of claims 3-10 and 12-19 are properly rejected under 35 USC 112 First Paragraph.

Issue 2: On pages 11-12 of the Appeal Brief, Appellant argues the rejection of claims 1-2 in view of US Patent 7,168,051 under Obvious-Type Double Patenting.

However, Appellant only argues that limitations presented in the instant application are not included within the claims of 7,168,051, and that limitations presented in 7,168,051 are not included in the instant claims. The differences between the claims are the reason why the double patenting rejection was not a statutory double patenting rejection. Rather, the differences between the instant claims are considered

to be obvious. Appellant never argues that the differences between 7,168,051 and the instant claims are not obvious. Therefore, the differences between the claims should be considered to be obvious for the reasons detailed in the Double Patenting rejection detailed above.

Issue 3: On pages 13-14, Appellant argues the rejection of claims 1-2 under 35 USC 103 over Mackinlay. More specifically, Appellant argues that the instant claims refer to a 3D desktop and a 2D desktop, while Mackinlay discloses a 3D document workspace, where such a workspace is not the same as a 3D desktop environment that interfaces the operating system of a computer system and a user.

First, it is noted that Appellant argues that the 3D desktop environment of the instant claims "interfaces the operating system of a computer system and a user." This limitation on the 3D desktop environment does not appear to be included in the instant claims. Further, as detailed in the Office Action dated 8/23/2007 on pages 22-23, "a desktop is a computer display area that represents the kind of objects one might find on a real desktop: documents, phonebook, telephone, reference sources, writing (and possibly drawing) tools, project folders." Meanwhile, Mackinlay's workspace is used to present at least documents of various types, which is an object that one might find on a real desktop.

Thus, as Appellant has not provided any passage in the specification that servers to limit the term "desktop," the term must be given its broadest reasonable interpretation

in light of the specification, which means that Mackinlay's workspace is equivalent to a desktop, as claimed.

Issue 4: On pages 14-15, Appellant argues "downloading a 3D program to convert the existing 2D desktop into a 3D desktop including an interpreter that dynamically converts any 2D data into 3D data presentable in the 3D desktop." Appellant further states "It is respectfully submitted that the present invention is not about downloading software from a Web. Rather the present invention as claimed is about downloading a software application from a Web to render an existing 2D desktop into a 3D desktop, including an interpreter to dynamically convert any 2D data into 3D data to be presented in the 3D desktop.

The CNET page shows that it was known to download applications of many types. For example, CNET would allow a user to download free virus scanners (which would be found in the Utilities link from the provided web page). Thus, a user downloading a virus scanner could be said to be "downloading a virus scanner program to scan for viruses on a computing system including a scanner that scans any files on the computer system." Further, a user downloading a driver could be said to be "downloading a driver program to provide an interface on a computer system between a hardware device and the operating system..." Thus, it is clear that a user who wishes to download the software of Mackinlay would be "downloading a 3D program to convert the existing 2D desktop into a 3D desktop," which is the functionality performed by Mackinlay. It is further noted that this the phrase "to convert the existing 2D desktop

into a 3D desktop" is simply the intended use of downloading the program. The remaining portion of the claim, "including an interpreter to dynamically convert any 2D data into 3D data to be presented in the 3D desktop" is included in Mackinlay (Column 5, lines 41-51), as addressed in the Office Action mailed 2/19/2008 on page 7. Thus, the downloaded software of Mackinlay would include the interpreter disclosed by Mackinlay.

Further, Appellant argues that the finding of obviousness was purely based on impermissible hindsight reasoning. However, it is noted that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Issue 5: On pages 15-16, Appellant argues that Mackinlay does not disclose "an interpreter that dynamically converts any 2D data into 3D data, where the interpreter is downloaded from a Web server and installed onto the local computer."

The phrase "where the interpreter is downloaded from a Web server" is addressed above in Issue 4 as being obvious. The remaining portion, "and installed onto the local computer" must be performed for any software to be implemented on a

computer after downloading, and is addressed in the rejection under 35 USC 103 as being obvious.

As for the "interpreter that dynamically converts any 2D data into 3D data," this is disclosed by Mackinlay. It is noted that this is not the phrase provided in the claim, but rather the claim states, "the interpreter dynamically converting the two-dimensional application program to a form useable in the three-dimensional computing environment." The processor described in the cited passage is used to convert Web pages into a suitable format for displaying in the document workspace, which is a 3D document workspace. The passage further states, "Instructions for performing such operations are retrieved from internal memory 103." This means that the processor performs the operations according to some code, or program. This program is equivalent to the claimed interpreter, as the program converts the Web pages into a suitable format for display in the document workspace.

Further, Appellant apparently focuses in part on the term "interpreter." However, the term "interpreter" is not interpreted as having any patentable weight, and is instead interpreted as being a label for the unit or module that performs the claimed functionality (e.g. "dynamically converting the two-dimensional application program to a form useable in the three-dimensional computing environment"). This functionality is clearly disclosed in the cited portion of Mackinlay, as Mackinlay converts the Web pages into a suitable format for display in the document workspace.

Issue 6: On pages 16-27, Appellant argues the rejection under 35 USC 103 of claims 3-11 and 12-20.

First, Appellant argues that each of the claims are allowable as the independent claims are allowable. However, as detailed Issues 3-5, this argument is erroneous, as the rejection of the independent claims are proper.

Second, Appellant argues that each of the dependent claims include limitations that are not obvious and that the Office Action was based on impermissible hindsight. First, it is noted that Appellant did not allege that the limitations of any of the dependent claim were not well known in the art. Further, Appellant did not provide any specific arguments with respect to any of the dependent claims, rather providing the same argument of "impermissible hindsight." As detailed, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As Appellant did not even assert that the argued limitations were not well known in the art, nor did Appellant argue that there would have been no motivation for the combination, the rejection of claims 3-11 and 12-20 should be maintained for the above reasons and the reasons provided in the rejection of the instant claims under 35 USC 103.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/S. C./

Examiner, Art Unit 2144

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444

Conferees:

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